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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,050	12/06/2001	Richard D. Rhodes	1998.4039.004	4395

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EXAMINER

THANH, QUANG D

ART UNIT	PAPER NUMBER
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3764

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/009,050

Applicant(s)

RHODES ET AL.

Examiner

Quang D. Thanh

Art Unit

3764

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1-17 and 19-26.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Continuation of 3. NOTE: The amendment has changed the scope of the claims requiring further consideration and/or search, for example in claim 1 adding "providing a seat incorporating more than one expandable chamber" is a further limitation never before considered.

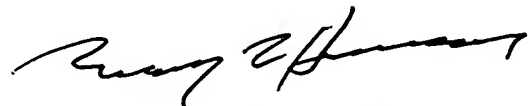
Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments filed 8/9/05 have been fully considered but they are not persuasive.

In response to applicant's argument that "Bullard teaches away from the incorporation of its constricting cuffs into a seat", the examiner respectfully disagrees. It is not that Bullard teaches away from the incorporation of its constricting cuffs into a seat, but rather Bullard teaches one form of applying pressure by expandable chambers contacting a portion of a user's body. Thomas is cited specifically to teach that it is well known in the art to use various alternative application (col. 5, lines 10-28) of an air massager cushioning device having a plurality of expandable chamber that can be utilized as a mattress (fig. 2), a seat cushion (fig. 14), a cuff apparatus (fig. 17-18) or incorporated in a lounge chair (fig. 16). Therefore, it would have been obvious to one of ordinary skill in the art to apply Bullard's cuff device in the form of seating device such as a lounge chair, as suggested and taught by Thomas, for the purpose of providing continuous overall cushioned support to the user seated in the seating device while alternating the areas of supporting contact portions, thereby reduce medical problems and/or fatigue caused by prolonged seating.

In response to applicant's argument that "To present a prima facie case for obviousness, lacking an express teaching in the prior art, the Office Action would have to have shown that the problem Bullard solved through active evacuation with the same as or similar to the problem that the inventor of the present invention solved through active evacuation as recited in claims 1 and 20", it is not required that the prior art disclose or suggest the properties newly-discovered by an applicant in order for there to be a prima facie case of obviousness. See *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897, 1905 (Fed. Cir. 1990). Moreover, as long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. See *In re Beattie*, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992); *In re Kronig*, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976) and *In re Wilder*, 429 F.2d 447, 166 USPQ 545 (CCPA 1970). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In this regard, a conclusion of obviousness may be based on common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

In response to applicant's argument that "Bullard teaches the use of active evacuation to solve the problem of how to constrict limbs in a peristaltic-like sequence (See column 8, lines 38-46), i.e., how to simulate the wavelike muscular contractions of tubular structures by which contents are forced onward toward an opening" that is different from the present invention, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).26.

In response to applicant's argument that "the commercial success of the invention, as set forth in the Declaration of Derren Rogers, militates against a finding of obviousness", it is noted that evidence of commercial success must be commensurate in scope with the scope of the claims: *In re Tiffin*, 448 F.2d 791, 171 USPQ 294 (1971). Further, in considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc; *In re Mageli et al.*, 176 USPQ 305 (CCPA 1973); *In re Noznick et al.*, 178 USPQ 43 (CCPA 1973). However, notwithstanding the opinions stated in the Derren Rogers declaration, there is no evidence that the sales of the embodiment containing the claimed invention were the direct result of any unique characteristics of the claimed invention and not due to other causes. See *In re Heldt*, 433 F.2d 808, 167 USPQ 676 (CCPA 1970). The statement the Derren Rogers declaration that the "The commercial success of this feature is evidence by the fact that, in that time, it has been purchased and implemented by General Motors, Cadillac, etc..." is mere speculation absent supporting evidence. Furthermore, evidence of commercial success is not established merely by showing the number of units sold. See *Kansas Jack, Inc. v. Kuhn*, 805 F.2d 1380, 219 USPQ 857 (Fed. Cir. 1983). Thus, there is no evidence in the record that the features recited in the claims on appeal were themselves responsible for the asserted commercial success. Therefore, it is noted that the subject matter here is regarded as clearly being obvious over the prior art, and it is well established that, in such a case, commercial success cannot be persuasive of patentability. *In re Coey et al.*, 38 CCPA 1200, 190 F.2d 347, 90 USPQ 216. In addition, evidence of commercial success is not controlling where, as here, the alleged invention seems to be clearly obvious in the sense of 35 U.S.C. 103. *In re Busch*, 45 CCPA 766, 251 F.2d 617, 116 USPQ 413, and cases there cited.



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